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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,590	11/25/2003	Stephen Russak	00467/100M163-US1	5682
7278	7590	10/20/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			VERBITSKY, GAIL KAPLAN	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,590

Applicant(s)

RUSSAK ET AL.

Examiner

Gail Verbitsky

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12 and 14-21 is/are rejected.
- 7) ☒ Claim(s) 5 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/25/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case, the claim language is confusing because, according to claim 1 which claim 8 is dependent on, the temperature sensor is a part of the first member, while according to claim 8, the temperature sensor is remote from the first and the second member.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 9-11, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (U.S.DES. 310037)[hereinafter Aoki].

Aoki discloses in Figs. 1-2, 6 a thermometer comprising a first disk-shaped member having upper and lower portions A and B and a circumferential edge C, a second disk-shaped member having top and bottom sides D and E and a circumferential edge F. As shown in Fig. 6 the disks are integrally connected by a

Art Unit: 2859

member joint G. As shown in Fig. 1, the device has a temperature display. This would imply, that the device has a temperature-sensing device with its circuitry. As shown in Fig. 6, the disk-shaped members under 90 degree angle to each other. As shown in the drawings, the joint member is flexible, slidably extendable and retractable.

(The numerals A-G have been added by the Examiner, see attachment # 1 to the Office Action).

With respect to the particular shape of the sensor, i.e., arcuate, tubular, or spherical, as stated in claims 2-4, the particular shape of the sensor, absent any criticality, is only considered to be an obvious modification of the shape disclosed by Aoki because the court has held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

With respect to the preamble of claim 1: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

With respect to claim 10: the particular shape of the first disk-shaped member, i.e., greater in thickness at the upper portion than at the lower portion, as stated in claim 10, absent any criticality, is only considered to be an obvious modification of the shape

Art Unit: 2859

disclosed by Aoki because the court has held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki in view of JP 61270631A.

Aoki disclose the device as stated above in paragraph 4.

Aoki does not explicitly teach an actuation switch, as stated in claim 12.

JP teaches an actuation button.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to add an actuation button, as taught by JP, to the device disclosed by Aoki, so as to allow the operator to turn the device on/ off, in order to improve the longevity of the device.

6. Claims 1-4, 6, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. DES. 356965).

Chang discloses in Figs. 1, 8 a thermometer comprising a first disk-shaped member having upper and lower portions A and B and a circumferential edge C, a second disk-shaped member having top and bottom sides D and E and a circumferential edge F. As shown in Fig. 8, the disks are integrally connected by a member joint G. As shown in Fig. 1, the device has a temperature display. This would imply, that the device has a temperature sensor. As shown in Fig. 8, the disk-shaped

Art Unit: 2859

members can position the disk-shaped members under 90-degree angle to each other. Since only the top disk-shaped member is a thermometer, it would imply, that both, the temperature sensor and its sensing circuit are positioned within the first disk-shaped member about its circumferential edge. (The numerals A-G have been added by the Examiner, see attachment # 1 to the Office Action).

With respect to the particular shape of the sensor, i.e., arcuate, tubular, or spherical, as stated in claims 2-4, the particular shape of the sensor, absent any criticality, is only considered to be an obvious modification of the shape disclosed by Chang because the court has held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

With respect to the preamble of claim 1: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

With respect to claim 10: the particular shape of the first disk-shaped member, i.e., greater in thickness at the upper portion than at the lower portion, as stated in claim 10, absent any criticality, is only considered to be an obvious modification of the shape disclosed by Chang because the court has held that a change in shape or configuration,

Art Unit: 2859

without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki in view of Chen (U.S. 6637935).

Aoki discloses the device as stated above 4.

Aoki does not explicitly state that the thermometer is watertight.

Chen discloses a device in the filed of applicant's endeavor wherein, the device/ thermometer is watertight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the device, disclosed by Aoki, watertight, as taught by Chen, so as to protect the device from moisture, and thus, to improve the longevity of the device.

8. Claims 17- 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP61270631A [hereinafter JP].

For claims 17, 20: JP discloses in Figs. 1a-c and 3 a clinical thermometer comprising a second member (disk-shaped) attached to a proximal end of a first member (an elongated arcuately shaped temperature probe), the second member has a proximal and a distal end. The first member has lower portion A and an upper portion B having a perimeter and an edge C along the perimeter; the temperature sensor is located at the edge C.

For claim 19: as shown in Fig. 1a, the second member is cylindrically shaped and disposed at the proximal end of the first member (probe).

For claim 18: the probe has a proximal end D and a distal end E.

For claim 21: JP discloses in Figs. 1a-c and 3 a (one piece) clinical thermometer comprising a first disk-shaped member having a circumferential edge and upper and lower portions, the member comprising a temperature display, an actuation switch and a temperature sensor/ probe positioned at the circumferential edge and connected to a circuitry inside the member. The temperature sensor/ probe is arcuate-shape.

As shown in Figs. 1a-c and 3, the temperature sensor/ probe is positioned at a point on the circumferential edge of the member. Since the member is of a circumferential shape, it is inherent, that, during the manufacturing process, the operator can select any point on the circumferential edge and thus, to position the temperature sensor/ probe at any desired position along the edge. (The numerals A-F have been added by the Examiner, see attachment # 3 to the Office action).

With respect to the preamble of claims 17 and 21: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki in view of JP.

Aoki discloses the device as stated above in paragraph 4.

Aoki does not explicitly teach the limitations of claims 6 and 7.

JP discloses a device comprising a disc-shaped member having a display displaying a temperature. The device has a circuitry wherein, it is inherent that a part of the circuitry is located within a disc-shaped member, and another part within another, measuring member.

For claim 6: a first disc-shaped member F contains (at least part of) a temperature sensing circuit. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to position the temperature sensing circuit in a first disc-shaped member, as taught by JP, so as to connect the circuit to a display, in order to display the measured temperature.

For claim 7: a second disc-shaped member F contains (at least part of) a temperature sensing circuit. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to position the temperature sensing circuit in a second disc-shaped member, as taught by JP, so as to connect the circuit to a display, in order to display the measured temperature.

10. Claims 1, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Des. 423956).

Chen discloses in Figs. 1 and 7 a device in the field of applicant's endeavor, the device comprising a first disk-shaped member A having a circumferential edge, upper and lower portions, a second disk-shaped member B having a circumferential edge and top and bottom sides, a tubular temperature sensor along the circumferential edge of

Art Unit: 2859

the first member. The members are integrally connected via a connecting joint. The second member of the device has a digital (electronic display). This would imply, that there is a temperature sensing circuit (wires) connecting the temperature sensor to the display. It is inherent, that in their connection, the temperature sensing circuit passing through the first member to the second member. The numerals A-B have been added by the Examiner, see attachment # 4 to the Office Action)

With respect to the preamble of claim 1: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Des. 423956) in view of JP.

Chen discloses the device as stated above in paragraph 10.

Chen does not describe that the temperature sensor is arcuate-shaped, as stated in claim 2.

JP teaches an arcuate-shaped temperature sensor, as shown in Fig. 2.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Chen, so as to have the temperature sensor of an arcuate shape, as taught by JP, because the particular shape of the temperature sensor, i.e., arcuate, absent any criticality, is only considered to be

Art Unit: 2859

an obvious modification of the shape disclosed by Chen because the court has held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

Allowable Subject Matter

10. Claims 5 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

It is not possible to apply a prior art to claim 8 due to the reasons stated above in paragraph 2.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky

Primary Patent Examiner, TC 2800



September 24, 2004